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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,998

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Andreas Eipper

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EXAMINER

LEE, DORIS L

ART UNIT

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1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,998	Applicant(s) EIPPER ET AL.	
	Examiner Doris L. Lee	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081027</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
2. No new grounds of rejection are set forth below. Thus, the following action is made final.

Double Patenting

Double patenting 1

3. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 9 and 10** of copending **Application No. 10/587,997** in view of **Dvornic et al (US 2002/016113)**.

The rejection is adequately set forth in paragraph 2 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

4. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 9 and 10 of commonly assigned copending Application 10/587,997.

The rejection is adequately set forth in paragraph 3 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 2

5. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12, 13, and 17-21** of copending Application **No. 11/576,646**.

The rejection is adequately set forth in paragraph 4 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

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6. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12, 13 and 17-21 of commonly assigned copending Application 11/576,646.

The rejection is adequately set forth in paragraph 5 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 3

7. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 11, 12, 15, 16, and 20-21** of copending Application **No. 11/577,009**.

The rejection is adequately set forth in paragraph 6 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

8. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 11, 12, 15, 16, and 20-21 of commonly assigned Application 11/577,009.

The rejection is adequately set forth in paragraph 7 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 4

9. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 5-9, 12-13, and 16-20** of copending **Application No. 11/577,587** in view of **Dvornic et al (US 2002/016113)**.

The rejection is adequately set forth in paragraph 8 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

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10. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 16-20 of commonly assigned Application 11/577,587.

The rejection is adequately set forth in paragraph 9 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 5

11. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, 17-21** of copending Application **No. 11/577,590**.

The rejection is adequately set forth in paragraph 10 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

12. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 17-21 of commonly assigned Application 11/577,590.

The rejection is adequately set forth in paragraph 11 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 6

13. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 6-11, and 13-14** of copending Application **No. 11/632,711**.

The rejection is adequately set forth in paragraph 12 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

14. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 6-11 and 13-14 of commonly assigned Application 11/632,711.

The rejection is adequately set forth in paragraph 13 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 7

15. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, and 15-16** of copending Application **No. 11/659,506**.

The rejection is adequately set forth in paragraph 14 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

16. Claims 1-13 directed to an invention not patentably distinct from claims 1, 5-9 and 15-16 of commonly assigned application 11/659,506.

The rejection is adequately set forth in paragraph 15 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 8

17. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 and 12-13** of copending Application **No. 11/659,625**.

The rejection is adequately set forth in paragraph 16 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

18. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9 and 12-13 of commonly assigned application 11/659,625.

The rejection is adequately set forth in paragraph 17 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 9

19. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,638**.

The rejection is adequately set forth in paragraph 18 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

20. Claims 1-13 directed to an invention not patentably distinct from claims 14, 19-23 and 25 of commonly assigned application 11/813,638.

The rejection is adequately set forth in paragraph 19 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 10

21. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,833**.

The rejection is adequately set forth in paragraph 20 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

22. Claims 1-13 directed to an invention not patentably distinct from claims 14, 19-23 and 25 of commonly assigned application 11/813,833.

The rejection is adequately set forth in paragraph 21 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 11

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23. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, and 16-20** of copending Application **No. 11/996,489**.

The rejection is adequately set forth in paragraph 22 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

24. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 16-20 of commonly assigned application 11/996,489.

The rejection is adequately set forth in paragraph 23 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Double patenting 12

25. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 13-14, and 18-20** of copending Application **No. 11/815,238**.

The rejection is adequately set forth in paragraph 24 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

26. Claims 1-13 directed to an invention not patentably distinct from claims 1, 5-9, 13-14 and 18-20 of commonly assigned application 11/815,238.

The rejection is adequately set forth in paragraph 25 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

27. **Claims 1-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gareiss et al (US 5,712,336)** in view of **Dvornic et al (US 2002/0161113)**.

The rejection is adequately set forth in paragraph 28 of the Office Action mailed on June 11, 2008 and is incorporated here by reference.

Response to Arguments

28. Applicant's arguments filed September 10, 2008 have been fully considered but they are not persuasive.

29. **Applicant's argument:** Applicants note that the present application was filed on August 1, 2006 which is on or before the filing applications listed in the first paragraph of the applicant's remarks mailed on 9/10/2008 (page 2). Applicants request the withdrawal of these rejections.

Examiner's response: As these are not the only rejections remaining against these claims, the obviousness double patenting rejection is maintained. See MPEP 804 (I) (B).

30. **Applicant's argument:** Dvornic does not make hyperbranched polyester polymers, and therefore, there is no hyperbranched polyester enablement in Dvornic.

Examiner's response: Dvornic states that it enables the synthesis of hyperbranched polyesters ([0008]).

31. **Applicant's arguments:** There is no teaching or suggestion found in Dvornic or Gareiss that blend provide molding compositions which have good flowability together with good mechanical properties.

Examiner's response: Gareiss teaches a composition which contains conventional additives (Abstract) and often, these additives are processing aids (col. 8, lines 55-65), thus Gareiss is open to the addition of compounds which may change the

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processability of the composition. Dvornic teaches that hyperbranched polyesters can be used in a wide variety of applications ([0002]) and indicates that highly branched polyesters give coating compositions a lower viscosity and better shear thinning properties ([0002]). As recited in the rejection of claim 1 above, it would be obvious to a person of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of Gareiss. One would have been motivated to do so to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic, [0002]); this controlling and changing of the processability referring to the change that would occur by lowering the viscosity and having better shear thinning properties (Dvornic, [0002]).

32. **Applicant's arguments:** The references do not teach or suggest all the recitations of the claim method.

Examiner's response: The rejection is adequately set forth in paragraph 25 of the Office Action mailed on June 11, 2008 and meets all the claimed limitations. As all the claims are compositional claims and the method steps are incorporated into product-by-process claim, patentability of said claim is based on the recited product and does not depend on its method of production. In re Marosi, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

33. **Applicant's arguments:** The references provide no guidance as to what result effective variable is achieved.

Examiner's response: It is obvious to a person of ordinary skill in the art that changing the glass transition temperature, the OH number and the COOH number will

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result in changes in the composition and as the ranges claimed in the instant application are so wide, it is also noted that the hyperbranched polyester disclosed in Dvornic will inherently have the instantly claimed glass transition temperature, OH number and COOH number since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. In *re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

34. **Applicant's arguments:** The applicants rebut the obviousness double patenting rejections and the obviousness rejections by a showing of unexpected or superior results.

Examiner's response: The data in Tables 4 and 5 have been considered, but the argument of unexpected results is not persuasive. Most notably, the data is not commensurate with the scope of the claims, for example the amount of the hyperbranched polyester ranges in amount from 1-5 % rather than the 0.01 to 50 % as recited in the instant claims. Also, according to the component B table, the Mn ranges from 1730 to 4370 g/mol rather than the 300 to 30,000 g/mol recited in the instant claims, the OH number ranges from 295 to 248 mg KOH/g rather than the 0 to 600 mg KOH/g recited in the instant claims.

Conclusion

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796